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**MAILED**

**JUL 19 2010**

**OFFICE OF PETITIONS**

In re Application of	:	
Kung et al.	:	
Application No. 10/590672	:	ON APPLICATION FOR
Filing or 371(c) Date: 08/24/2006	:	PATENT TERM ADJUSTMENT
Attorney Docket Number:	:	
20363-025 NATL	:	

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b)," filed March 12, 2010. Applicants petition for reconsideration of the patent term adjustment calculation to 69 days, not zero (0) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicant requests this correction based upon (1) an assertion that the Office erred in failing to calculate two delays of 92 days, and (2) on the basis that the Office will take in excess of three years to issue this patent.

The Application for Patent Term Adjustment Including Request for Reconsideration of Patent Term Adjustment ("PTA") under 37 CFR 1.705(b), as it relates to the assertion that the Office erred in failing to calculate delays of 184 days is **GRANTED to the EXTENT INDICATED.**

The Application for Patent Term Adjustment Including Request for Reconsideration of Patent Term Adjustment ("PTA") under 37 CFR 1.705(b), as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE.**

On December 15, 2009, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is zero (0) days.

On March 12, 2010, applicant timely submitted the instant application for patent term adjustment<sup>1</sup>. Applicants request that the Determination of Patent Term Adjustment be corrected from zero (0) days, as indicated on the Determination of PTA mailed December 15, 2009, to an adjustment of 69 days. Applicants aver that the Office may have erred in failing to calculate two delays of 92 days, and (2) on the basis that the Office will take in excess of three years to issue this patent.

<sup>1</sup> PALM records show that the Issue Fee payment was received in the Office on March 12, 2010.

As to the assertion that the Office erred in failing to calculate two delays of 92 days, the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) mailed September 1, 2009 indicates a patent term of zero (0) days. The instant request for reconsideration of patent term adjustment indicates that the Office may have erred in failing to calculate an adjustment 92 days in connection with the filing of a reply to a Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US), on October 23, 2007, three (3) months and 92 days after the mail date of the Notification, and also failed to calculate an adjustment 92 days in connection with the filing of an information disclosure statement ("IDS") on May 26, 2009, after filing a response to a Restriction/Election Requirement on February 23, 2009.

Office records reveal that a Notification of Missing Requirements Under 35 U.S.C. 371 was mailed on April 23, 2007. Applicants filed a response to the Notification of Missing Requirements on October 23, 2007. The reduction commenced July 24, 2007, the day after the date that is three months after the date of mailing of the Notification of Missing Requirements, and ending on the date the reply was filed, October 23, 2007. As such, pursuant to 37 CFR 1.704(b), the application is assessed a reduction of 92 days.

Office records reveal further that Applicants filed the response to the Restriction/Election Requirement on February 23, 2009. Thereafter, Applicants filed an IDS on May 26, 2009. The reduction commenced February 24, 2009, the day after the date that the response to the Restriction/Election Requirement was filed, and ending on the date the IDS was filed, May 26, 2009. As such, pursuant to 37 CFR 1.704(c)(8), the application is assessed a reduction of 92 days.

In view thereof, as of the time of allowance, the application is entitled to an overall patent term adjustment of zero days (adjustments totaling 30 days less reductions totaling 262 days).

As to the Office's failure to issue the patent within 3 years of the filing date, knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is


advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee<sup>2</sup>.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Any request for reconsideration of the patent term adjustment indicated on the patent, including any request as it relates to the Office's failure to issue the patent within 3 years of the filing date, must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and **must** include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this matter should be directed to Attorney Derek Woods at (571) 272-3232.



Anthony Knight  
Director  
Office of Petitions

Enclosure: Copy of Adjustment PAIR Calculations

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<sup>2</sup> For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

Day : Thursday

**PALM INTRANET**

Date: 7/1/2010

Time: 10:18:09

**PTA Calculations for Application: 10/590672**

Application Filing Date:	10/23/2007	PTO Delay (PTO):	30
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	78
Post-Issue Petitions:	0	Total PTA (days):	0
PTO Delay Adjustment:	-184		

**File Contents History**

Number	Date	Contents Description	PTO	APPL	START
61	07/01/2010	ADJUSTMENT OF PTA CALCULATION BY PTO		184	
51	12/15/2009	MAIL NOTICE OF ALLOWANCE			
50	11/17/2009	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		78	37
49	12/07/2009	ISSUE REVISION COMPLETED			
48	12/07/2009	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
47	12/07/2009	CASE DOCKETED TO EXAMINER IN GAU			
46	12/04/2009	ALLOWED CASE RETURNED TO THE EXAMINER FOR CLERICAL PROCESSING			
45	12/04/2009	DOCUMENT VERIFICATION			
44	11/30/2009	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
43	12/03/2009	EXAMINER'S AMENDMENT COMMUNICATION			
42	12/03/2009	NOTICE OF ALLOWABILITY			
41	11/16/2009	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
40	11/17/2009	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
39	11/17/2009	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
38	09/25/2009	DATE FORWARDED TO EXAMINER			
37	08/31/2009	RESPONSE AFTER NON-FINAL ACTION			
36	06/01/2009	MAIL NON-FINAL REJECTION			
35	05/29/2009	NON-FINAL REJECTION			
34	05/26/2009	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
33	05/26/2009	INFORMATION DISCLOSURE STATEMENT			

		CONSIDERED			
32	05/26/2009	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
31	05/26/2009	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
24	04/02/2009	DATE FORWARDED TO EXAMINER			
23	02/23/2009	RESPONSE TO ELECTION / RESTRICTION FILED			
22	01/22/2009	MAIL RESTRICTION REQUIREMENT	30		10
21	01/19/2009	REQUIREMENT FOR RESTRICTION / ELECTION			
20	06/30/2008	PRELIMINARY AMENDMENT			
19	08/14/2008	PG-PUB ISSUE NOTIFICATION			
18	07/01/2008	CASE DOCKETED TO EXAMINER IN GAU			
17	06/20/2008	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
16	06/20/2008	MAIL NON-COMPLIANT PRELIMINARY AMENDMENT			
15	04/30/2008	CORRECTED FILING RECEIPT			
14	06/20/2008	NON-COMPLIANT PRELIMINARY AMENDMENT			
11	05/01/2008	APPLICATION DISPATCHED FROM OIPE			
10	10/23/2007	371 COMPLETION DATE			
9	04/22/2008	SENT TO CLASSIFICATION CONTRACTOR			
8	04/22/2008	FILING RECEIPT			
7	04/22/2008	NOTICE OF DO/EO ACCEPTANCE MAILED			
6	10/23/2007	ADDITIONAL APPLICATION FILING FEES			
5	10/30/2007	PRELIMINARY AMENDMENTS			
4	10/23/2007	A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC			

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#### EXPLANATION OF PTA CALCULATION

#### EXPLANATION OF PTE CALCULATION

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